



1 back” Exhibits A-L. (Pl.’s Privilege Br., Doc. #107 at 2:2-16.)<sup>2</sup> Spot asserted a number of privilege  
2 objections with regard to the exhibits, which Spot had previously produced and LightGuard had  
3 attempted to utilize during the depositions. (*Id.*) Following the depositions, LightGuard and Spot  
4 were unable to resolve the dispute and, on November 21, 2011, LightGuard filed an Emergency  
5 Motion to Compel. (Doc. #74.)

6 On December 5, 2011, the court held a hearing on the discovery dispute. (Doc. #91.) During  
7 the hearing, the court resolved all matters relating to the Burnham and Peddie depositions. The court  
8 further ordered LightGuard and Spot to file simultaneous briefs on the privilege dispute, which  
9 concerned the two groups of documents referenced above: Exhibit A and Exhibits B-L, and also  
10 Exhibit M (Spot’s privilege log). (*Id.*)

11 The first, Exhibit A, is a five-page document created by Spot’s vice-president, Burnham, on  
12 May 6, 2005. (Joint Stip. Ex. List (#105) at Ex. A.) It consists of independent research and marginal  
13 notes. (*Id.*) According to Spot, Exhibit A was created to assist Spot’s counsel, Seed IP, in the creation  
14 of a “Freedom to Operate” (“FTO”) plan. (*Id.*) The second group, Exhibits B-L, consists of a  
15 collection of operating plans, sales and financial reports, and PowerPoint presentations that were  
16 presented to Spot’s board of directors. (*Id.* at Ex. B-L.) The third group, Exhibit M, is Spot’s  
17 December 1, 2011, privilege log. (*Id.* at Ex. M.) Exhibit M identifies numerous documents (primarily  
18 emails and attachments thereto), which Spot claims are privileged. (*Id.*) The court ordered the parties  
19 to submit simultaneous briefs addressing whether any privileges (primarily, the attorney-client  
20 privilege and work product doctrine) attach to the aforementioned documents.

21 On December 30, 2011, LightGuard and Spot filed simultaneous briefs, addressing the question  
22 of whether Spot’s Exhibits A, B-L, and M should be protected by the attorney-client privilege, work  
23 product doctrine, or both. (Docs. #107, #109.) On January 19, 2012, after reviewing LightGuard and  
24 Spot’s briefs, the court sought further clarification on six discrete points and ordered the parties to file  
25 supplemental briefs as to those issues. (Doc. #115). Clarifying briefs were filed by the parties on  
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27 <sup>2</sup> Exhibit M is a privilege log pertaining to numerous emails and attachments. Unlike Exhibits A-L,  
28 the emails and attachments in Exhibit M had not been previously produced to LightGuard.

1 January 30, 2012. (Docs. #119, #121.)

2 On February 15, 2012, the court heard arguments on the privilege issues, discussed in greater  
3 detail below, *see infra* pp. 4-5.

4 ***B. LightGuard & Spot's Payment Dispute***

5 LightGuard and Spot's second discovery dispute, which concerns fees owed to a discovery  
6 vendor, arose out of a different set of facts. On February 22, 2011, and March 28, 2011, LightGuard  
7 issued two document requests. (Doc. #126-1.) On July 27, 2011, and September 30, 2011, Spot  
8 produced the requested documents. (*Id.* at 5:6-14.) Pursuant to Federal Rule of Civil  
9 Procedure 34(b)(2)(B), Spot explained that the documents were available for LightGuard's inspection  
10 and copying. (Doc. #123 at 2:22-28.)

11 Meanwhile, however, Spot and LightGuard exchanged a flurry of emails and letters debating,  
12 first, how to produce the documents and whether to hire Sierra Legal Duplicating, Inc. ("Sierra Legal")  
13 to process and copy Spot's responsive production. (*See, e.g.*, Doc. #123 at 2-4.) The second question  
14 was whether LightGuard, Spot, or both should bear the cost of Sierra Legal's services. (Doc. #125 at  
15 3-6) (recounting these events).)

16 On May 13, 2011, LightGuard invited Spot to split copying costs that would be incurred as a  
17 result of hiring Sierra Legal. (Doc. #124 at Ex. A.) Although Spot did not directly respond to  
18 LightGuard's invitation, Spot repeatedly stated that it would "not incur the cost of making copies in  
19 this litigation." (Doc. #126-2 at 2.) Despite this clear and repeated rejection of LightGuard's offer  
20 (*see* Doc. #126-3 at 2, Doc. #126-4 at 3, Doc. #126-7 at 2) (stating Spot would "not incur the cost of  
21 making copies in this litigation")), LightGuard allegedly believed that a cost splitting agreement had  
22 been reached. (Doc. #123.) However, LightGuard never confirmed this "agreement" in writing.  
23 Subsequently, Sierra Legal collected, processed, and converted Spot's documents into a format  
24 compatible with LightGuard's data management software. (Def.'s Payment Br., Doc. #125 at 5:5-8.)

25 On October, 28, 2011, LightGuard and Spot received an invoice from Sierra Legal for its  
26 services. (Pl.'s Payment Br., Doc. #123 at 3:25-26.) Assuming that Spot and LightGuard had agreed  
27 to split copying costs, LightGuard only paid half of the bill, which amounted to \$11,554.58. (*Id.* at  
28 1:20-21.) Spot, however, refused to pay the other half of the bill, which amounted to \$11,396.80. (*Id.*

at 1:18-19.) Unable to resolve the matter amicably, the parties brought the issue to the court's attention during a January 24, 2012, status conference. (Doc. #118.) The parties were ordered to submit briefs on the matter for the court's review, which they did on February 9, 2012. (Doc. #123; Doc. #125; *see infra* pp. 20-22 (discussing LightGuard and Spot's payment dispute).)

**C. The February 15, 2012, Hearing & Subsequent Proceedings**

On February 15, 2012, the court held a hearing on both discovery disputes. (Doc. #127.)

**I. Exhibit A**

Regarding Exhibit A, Spot reiterated its position that Exhibit A is protected by the attorney-client privilege and not the work product doctrine. Spot referenced a footnote in its brief alleging that Spot sent an email to Seed IP on May 24, 2005, discussing Exhibit A's contents. (*See* Doc. #109 at 2 n.1 ("Spot Devices can submit to the Court for *in camera* review an e-mail between Seed IP and Spot Devices on May 24, 2005 discussing the contents of Exhibit A").) Spot could not, however, confirm whether the May 24, 2005 email was included in any of its privilege logs. (Doc. #127.) As a result, the court ordered Spot to provide a copy of the email for *in camera* review and ordered both parties to submit simultaneous briefs as to whether Spot's failure to include the May 24, 2005 email in a privilege log waived Spot's alleged attorney-client privilege. (*Id.*)

**ii. Exhibit B-L**

With regard to Exhibits B-L, Spot stated that the exhibits are protected by the attorney-client privilege and an alleged oral agreement between LightGuard and Spot. (*Id.*) According to Spot, the agreement permitted LightGuard to utilize the exhibits during the deposition in exchange for LightGuard's assurances that LightGuard would *never* contest that the exhibits are privileged and that the privilege had not been waived. (*See* Def.'s Suppl. Br., Doc. #121 at 4-6.) As explained in greater detail below, *see infra* at pp. 14-17, the court concluded that the attorney-client privilege does not apply to Exhibits B-L. (Doc. #127.)

**iii. Exhibit M**

With regard to Spot's privilege log, Exhibit M, the court was unable to determine if the documents referenced in the log complied with the factors enunciated in *Dole v. Milonas*, 889 F.2d 885, 888 n.3 (9th Cir. 1989), which requires privilege logs to identify: (1) the attorney and client

involved; (2) the nature of the document; (3) all person or entities shown on the document to have received the document; (4) all persons or entities known to have been furnished the document or informed of its substance; and (5) the date the document was created. *Id.*; *see also In re Grand Jury Investigation*, 974 F.2d 1086, 1071 (9th Cir. 1989) (also requiring these factors). As a result, the court ordered Spot to produce the documents listed in Exhibit M for *in camera* review in order to determine whether the attorney-client privilege applies to any of the documents. (Doc. #127.)

On February 24, 2012, LightGuard and Spot submitted briefing on whether Spot's failure to include the May 24, 2005, email in a privilege log waived Spot's alleged attorney-client privilege. (See Doc. #131; Doc. #132.) Spot acknowledged, *see* (Doc. #129 at 2), that its December 1, 2011, privilege log, Exhibit M, did not list the May 24, 2005, email as privileged. However, Spot submitted a new privilege log, dated January 19, 2012, which does identify the May 24, 2005, email as privileged. (Doc. #129-1; Doc. #130.) Spot also submitted the emails and attachments listed in its December 1, 2011, privilege log, Exhibit M, for *in camera* review. (See Doc. #131.)

#### *iv. Vendor Payment Dispute*

Finally, with regard to LightGuard and Spot's payment dispute, the court ruled that Spot shall only be liable for the costs associated with converting the documents into LightGuard's requested format. (*Id.*) Because the court could not discern the amount of those expenses from Sierra Legal's invoice, the parties were ordered to independently determine the appropriate cost. (*Id.*) If the parties were unable to agree on apportionment of expenses, the parties were to return to court with documentation.

## **II. LEGAL STANDARD**

The **attorney-client privilege** protects confidential communications between attorneys and clients that are made for the purpose of giving or receiving legal advice. *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981). It extends only to communications and not to facts. *Id.*, at 395-96 (quoting *Philadelphia v. Westinghouse Elec. Corp.*, 205 F.Supp. 830, 831 (D. Pa. 1962)). The burden of proving the privilege rests on the party asserting the privilege. *United States v. Martin*, 278 F.3d 988, 999-1000 (9th Cir. 2002).

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1 In the Ninth Circuit, an attorney-client privilege exists (1) where legal advice of any kind is  
 2 sought, (2) from a professional legal advisor in his or her capacity as such, (3) the communications  
 3 relating to that purpose, (4) made in confidence, (5) by the client, (6) are, at that instance, permanently  
 4 protected, (7) from disclosure by the client or by the legal advisor, and (8) unless the protection is  
 5 waived.” 8 Wigmore, Evidence § 2292 (1961); *see also United States v. Graf*, 610 F.3d 1148, 1156  
 6 (9th Cir. 2010). When determining whether a document seeks legal advice, courts have examined the  
 7 nature, content, and context in which the document was prepared. *AT&T Corp. v. Microsoft Corp.*,  
 8 2003 WL 21212614 at \*3 (N.D. Cal. 2003) (citing *Bio-Rad Lab., Inc. v. Pharmacia, Inc.*, 130 F.R.D.  
 9 116, 126 (N.D. Cal. 1990)). Blanket assertions of attorney-client privilege are “extremely disfavored.”  
 10 *Martin*, 278 F.3d at 1000. Because the privilege impedes full and free discovery, it is strictly  
 11 construed. *Weil v. Inv. Indicators, Research & Mgmt., Inc.*, 647 F.2d 18, 24 (9th Cir. 1981).

12 By contrast, the **work product doctrine** protects attorneys’ thought processes and legal  
 13 recommendations. *Hickman v. Taylor*, 329 U.S. 495, 510-11 (1947). To qualify for protection against  
 14 discovery under the work product doctrine, documents must: (1) “be ‘prepared in anticipation of  
 15 litigation or for trial,’ and (2) be prepared ‘by or for another party or by or for that other party’s  
 16 representative.’” *In re Grand Jury Subpoena (Mark Torf/Torf Envtl. Mgmt.)*, 357 F.3d 900, 907  
 17 (9th Cir. 2004) (citing *In re California Pub. Utils. Comm’n*, 892 F.2d 778, 780-81 (9th Cir. 1989)).  
 18 “In circumstances where a document serves a dual purpose, that is, where it was not prepared  
 19 exclusively for litigation, then the ‘because of’ test is used.” *United States v. Richey*, 632 F.3d 559,  
 20 567-68 (9th Cir. 2011) (citing *In Re Grand Jury Subpoena*, 357 F.3d at 907). “Dual purpose  
 21 documents are deemed prepared because of litigation if ‘in light of the nature of the document and the  
 22 factual situation in the particular case, the document can be fairly said to have been prepared or  
 23 obtained because of the prospect of litigation.’” *Id.* In applying the “because of” standard, courts must  
 24 consider the totality of the circumstances and determine whether the “document was created because  
 25 of anticipated litigation, and would not have been created in substantially similar form but for the  
 26 prospect of litigation.” *Id.* As in the case of the attorney-client privilege, the party claiming the  
 27 protection bears the burden of demonstrating the applicability of the work product doctrine. *Tornay v.*  
 28 *U.S.*, 840 F.2d 1424, 1426 (9th Cir. 1988) (citing *U.S. v. Hirsch*, 803 F.2d 493, 496 (9th Cir. 1986)).

Finally, regarding the **document duplication expense issue**, Federal Rule of Civil Procedure 34, which governs the procedures for document production, requires the responding party “to produce and permit the requesting party or its representative to inspect, copy, test, or sample . . . any designated documents or electronically stored information.” Fed. R. Civ. Pro. 34(a)(1)(A). “[T]he presumption is that the responding party must bear the expense of complying with discovery requests.” *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 340, 358 (1987). This includes the expense of answering interrogatories, submitting to depositions, and producing documents for the requesting party’s inspection, copying, testing, or sampling. *In re Puerto Rico Elec. Power Authority*, 687 F.2d 501, 508 (P.R. Cir. 1982).

All other expenses, however, are subject to the presumption that each party bears the “ordinary burden of financing his own suit.” *See Eisen v. Carlisle & Jacquelin*, 417 U.S. 156, 94 (1974). This undoubtedly includes copying expenses. *Tierno v. Rite Aid Corp.*, No. 05-02520, 2008 WL 3876131 at \*1 (N.D. Cal. Aug. 19, 2008) (citing 7 *Moore’s Federal Practice* § 34.13[5] at 34-92 (2008) (“A party producing documents will ordinarily not be put to the expense of making copies for the requesting party”)); *see also Bills v. Kennecott Corp.* 108 F.R.D. 459, 462 (D. Utah 1985) (“Ordinarily, the producing party bears the costs of reviewing and gathering documents while the requesting party pays for the costs of the copies only”); *Clear View Investments, Ltd. v. Oshatz*, 233 F.R.D. 393, 394 (S.D.N.Y. 2006) (stating the same); *Obiajulu v. City of Rochester, Dept. of Law*, 166 F.R.D. 293, 297 (W.D.N.Y. 1996) (stating the same).

### **III. DISCUSSION**

#### ***A. Exhibit A is not Protected by the Attorney-Client Privilege***

Exhibit A is a five-page document created by Spot’s vice-president, Burnham, on May 6, 2005. (Joint Stip. Ex. List, Doc. #105 at Ex. A.) It consists of independent research and marginal notes. (*Id.*) According to Spot’s arguments, the document was created to assist Spot’s counsel, Seed IP, in the creation of a “Freedom to Operate” (“FTO”) protocol. (*Id.*) Spot contends that Exhibit A is protected by the attorney-client privilege because “the document reveals confidential communications . . . between Spot Devices and Seed IP.” (Def.’s Opp., Doc. #109 at 2.) After reviewing the parties’ briefs and relevant law, the court concludes that Exhibit A is not protected by the attorney-client privilege.



1 For ease of analysis, the court will discuss, first, why Exhibit A's four corners militate against  
 2 protection and, second, why the supplemental evidence proffered by Spot (*i.e.*, the May 24, 2005  
 3 email) fails to demonstrate that Exhibit A is entitled to protection.

4 *i. The record is adequate and the court's determination of whether Exhibit A is*  
 5 *protected by the attorney-client privilege is ripe*

6 As a preliminary matter, the court addresses Spot's contention that "the current record is  
 7 inadequate for the Court to be able to" determine whether the attorney-client privilege attaches to  
 8 Exhibit A and the May 24, 2005, email between Spot and Seed IP, which purportedly discusses  
 9 Exhibit A's contents. (Def.'s *In Cam.* Stat. Doc. #131 at 1:16-17.) Before deciding whether the  
 10 attorney-client privilege applies to disputed documents, district courts are directed to develop an  
 11 appropriate record and to afford the parties an opportunity to present their arguments in writing and, if  
 12 necessary, undertake an *in camera* review. *Portman v. County of Santa Clara*, 995 F.2d 898, 903 (9th  
 13 Cir. 1993) (citation omitted) (stating that the prudential component of the ripeness doctrine focuses  
 14 on "whether there is an adequate record upon which to base effective review"); *see also In re Pittman*,  
 15 00-7195 2000 WL 1580968 at \*1 (D.C. Cir. Sept. 1, 2000) (requiring the exact procedures this court  
 16 has just completed in order to establish the base of an effective review). Because the court has  
 17 afforded Spot numerous opportunities to present its arguments and has conducted an *in camera* review,  
 18 the court rejects Spot's assertion that the record is inadequate.

19 The court has developed the record with care and has given Spot ample opportunities to present  
 20 evidence demonstrating that Exhibit A is protected by the attorney-client privilege. On December 5,  
 21 2011, and February 15, 2012, the court held hearings on whether Exhibit A is protected by the  
 22 attorney-client privilege. (*See* Doc. #91; Doc. #127.) In addition, Spot has submitted three briefs  
 23 addressing the question of whether Exhibit A is protected by the attorney-client privilege, including  
 24 a supplemental brief submitted in response to the court's request for clarification. (*See* Def.'s Br.  
 25 Doc. #109 at 2; Def.'s Suppl. Br., Doc. #121 at 2; Def.'s *In Cam.* Stat., Doc. #131 at 1; *see also* Order  
 26 Doc. #115 (requesting clarification from the parties).) Finally, following the February 15, 2012,  
 27 hearing, the court conducted an *in camera* review of Exhibit A and an email, dated May 24, 2005.

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1 According to Spot, the email, which was between Spot and Seed IP, allegedly discussed Exhibit A's  
2 contents and communicated Exhibit A to Spot's attorneys.

3 Therefore, Spot's assertion that the record is inadequate is unfounded. Before deciding  
4 whether Exhibit A is protected by the attorney-client privilege, the court has reviewed Spot's briefs,  
5 declarations, affidavits, privilege logs, requested supplemental briefs, held two hearings, and  
6 conducted an *in camera* review of allegedly privileged documents. As a result, the court will now  
7 proceed to its discussion of whether or not Exhibit A is entitled to protection under the attorney-client  
8 privilege.

9 ***ii. Exhibit A's four corners do not demonstrate that it is protected by the attorney-client***  
10 ***privilege***

11 Exhibit A's four corners do not indicate that it is entitled to protection under the attorney-client  
12 privilege. First, Spot—upon whom the burden of proving that the attorney-client privilege applies—has  
13 failed to demonstrate that Exhibit A was created for the purpose of soliciting legal advice. *See Upjohn*,  
14 499 U.S. at 389 (stating that the attorney-client privilege protects communications that are made for  
15 the purpose of obtaining legal advice). When determining whether a document seeks legal advice,  
16 courts have examined the *nature*, *content*, and *context* in which the document was prepared. *AT&T*  
17 *Corp. v. Microsoft Corp.*, 2003 WL 21212614 at \*3 (N.D. Cal. 2003) (citing *Bio-Rad Lab. Inc. v.*  
18 *Pharmacia, Inc.*, 130 F.R.D. 116, 126 (N.D. Cal. 1990)).

19 Here, Exhibit A's *nature* appears to be an internal business memorandum. The document's  
20 introduction plainly states that it was created to review the status of various patents in order to limit  
21 the amount of work Seed IP would perform. (*See* Joint Stip. Ex. List, Doc. #105 at Ex. A. (“Our  
22 intent behind this research was to provide a thorough review of all potentially related patents in order  
23 to narrow down the time/expense for Seed IP to generate an FTO”).) This language is significant for  
24 two reasons. First, taken along with the heading which identifies Burnham as the author, the  
25 introduction indicates that Exhibit A was created without the assistance of counsel. Second, the  
26 inclusion of the phrase, “in order to narrow down the time/expense for Seed IP” in the introduction,  
27 strongly suggests that the purpose of Exhibit A was to screen information from, rather than

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1 communicate information to, counsel. This conclusion is bolstered by the fact that Exhibit A is not  
2 addressed to anyone and does not pose questions to anyone, counsel in particular.

3 Similarly, Exhibit A's *content* indicates that it is not entitled to protection. Although Exhibit A  
4 purports to perform a "legal review," the review was conducted by Burnham, who is not an attorney.  
5 Moreover, no attorneys participated in Exhibit A's creation, as Exhibit A states, "[t]his assessment of  
6 patents was compiled by Thomas Burnham, with engineering input from 219 Design." (Joint Stip. Ex.  
7 List (#105) at Ex. A.)

8 Finally, the *context* in which Exhibit A was prepared does not indicate that it should be  
9 protected. Although Spot maintains that it was created in anticipation of litigation, Spot has failed to  
10 direct the court's attention to a single phrase in the document suggesting as much. Similarly, as  
11 discussed below, Spot has also failed to produce any extrinsic evidence indicating that Exhibit A was  
12 ever sent to an attorney or created within the context of impending litigation. Without any evidence  
13 to corroborate Spot's naked allegations, the court must conclude that Exhibit A originated in the  
14 regular course of business. That Exhibit A was intended for business purposes is, after all, strongly  
15 suggested by the introduction. It plainly states that Exhibit A was created for the purpose "of reducing  
16 the number of constraints on Spot Devices' future designs." (Joint Stip. Ex. List, Doc. #105 at Ex. A.)  
17 Importantly, the introduction memorializing the context of Exhibit A's creation makes no mention of  
18 impending litigation. (*Id.*) Rather, the context appears to be simply business oriented. The court  
19 cannot, therefore, conclude that Exhibit A was created for the purpose of obtaining legal advice.

20 In addition to Spot's failure to demonstrate that Exhibit A seeks legal advice, Spot has also  
21 failed to demonstrate that Exhibit A qualifies as a communication for purposes of the attorney-client  
22 privilege. Nothing within Exhibit A's four corners suggest that it is a communication. Exhibit A's  
23 format suggests that it is an internal business memorandum for Spot and Burnham's private use. The  
24 document is not addressed to anyone and contains no evidence of having been received by anyone,  
25 such as a date stamp. Exhibit A's tone and style also suggest that it is an internal business  
26 memorandum and not a communication to counsel. The document is written in a casual style, is filled  
27 with hand-written notes and, as discussed above, states that it was created to screen information from,  
28 rather than communicate information to, counsel.

1           Given that Spot has failed to demonstrate that Exhibit A was created for the purpose of  
2 obtaining legal advice or is a communication for purposes of the attorney-client privilege, the court  
3 cannot conclude that it is entitled to protection under the attorney-client privilege.

4           ***iii. Spot's supplemental evidence fails to demonstrate that Exhibit A is protected by***  
5           ***the attorney-client privilege***

6           To resuscitate its contention that Exhibit A is protected by the attorney-client privilege, Spot  
7 made various representations to the court that it could produce additional evidence demonstrating that  
8 Exhibit A is was created to obtain legal advice. These representations, which were made initially in  
9 its briefs and subsequently at the February 15, 2012 hearing, alleged that Spot could produce a May 24,  
10 2005 email between Spot and Seed IP discussing the contents of Exhibit A as well as a privilege log  
11 identifying the May 24, 2005, email as protected by the attorney-client privilege. (*See* Doc. #109 at  
12 2 n.1.) Additionally, Spot produced a declaration by Thomas Burnham stating that Exhibit A was  
13 prepared "for the sole purpose" of obtaining legal advice. (*See* Burnham Decl., Doc. #122 at 1:8-11.)

14           Spot's representations, however, fail for several reasons. First, during the February 15, 2012,  
15 hearing, the court noted that Spot's privilege log, Exhibit M, did not identify the May 24, 2005 email  
16 as privileged. (Doc. #127.) Consequently, Spot promised to provide a new privilege log, identifying  
17 the May 24, 2005 email as privileged and accurately describing its contents. (*Id.*) However, Spot's  
18 new privilege log, dated January 19, 2012, does not accurately represent the contents of the May 24,  
19 2005 email. (*See* Doc. #130 at 15.) As discovered by the court during its *in camera* review, the  
20 January 19, 2012 privilege log states that the May 24, 2005 email seeks legal advice and was sent to  
21 three attorneys. However, the May 24, 2005 email neither seeks legal advice nor was sent to three  
22 attorneys.

23           Second, in both its December 30, 2011 privilege brief and during the February 15, 2012  
24 hearing, Spot represented that it could produce a May 24, 2005 email between Spot and Seed IP  
25 discussing the content of Exhibit A. (*See* Doc. #109 at 2 n.1) ("Spot Devices can submit to the Court  
26 for *in camera* review an e-mail between Seed IP and Spot Devices on May 24, 2005 discussing the  
27 contents of Exhibit A").) However, as discovered by the court during its *in camera* review, Spot's  
28 representations to the court did not accurately reflect the contents of the May 24, 2005 email. Whereas

1 Spot assured the court that the May 24, 2005 email discussed the contents of Exhibit A, scrutiny of the  
2 May 24, 2005 email reveals that it makes no mention of Exhibit A. In fact, it does not even discuss  
3 issues germane to this case or state anywhere that Spot was seeking advice or input from counsel.

4 In sum, Spot was not only slow to produce its supplemental evidence, but the evidence it did  
5 produce was contradictory. Spot's initial privilege log made no reference to the May 24, 2005 email.  
6 However, when Spot did produce a privilege log identifying the May 24, 2005 email, the privilege  
7 log's description of the May 24, 2005 email contradicted the email's actual contents. The privilege  
8 log states that the May 24, 2005 email seeks legal advice. However, the May 24, 2005 email does not  
9 seek legal advice. Similarly, Spot's assertions in its brief that the "e-mail between Seed IP and Spot  
10 Devices on May 24, 2005 discuss[es] the content of Exhibit A" is contradicted by what the actual  
11 May 24, 2005 email addresses. (*See* Doc. #109 at 2 n.1.) On these facts, the court cannot conclude  
12 that Spot has satisfied its burden of demonstrating that either the May 24, 2005 email or Exhibit A are  
13 entitled to protection under the attorney-client privilege.

14 This leaves the Burnham declaration as only possible basis for concluding that Exhibit A might  
15 be protected by the attorney-client privilege. According to the Burnham declaration, Burnham  
16 "collected the information and prepared Exhibit A for the sole purpose of presenting the information  
17 to Spot Devices lawyers at Seed IP seeking advice regarding potential infringement of and the scope  
18 of the patents included in the May 6, 2005 memo. The memo was in fact given to and discussed with  
19 the attorneys at Seed IP." (Burnham Decl., Doc. #122 at 1:8-11.)

20 However, two facts detract from the credibility of the Burnham declaration. First, the Burnham  
21 declaration's unequivocal statement that Exhibit A was created "for the sole purpose of presenting the  
22 information to Spot Devices lawyers at Seed IP" directly contradicts Burnham's earlier statement,  
23 memorialized on Exhibit A's face, that the document was created to provide an internal review of  
24 various patents. (Burnham Decl., Doc. #122 at 1:8-11; Joint Stip. Ex. List, Doc. #105 at Ex. A.)  
25 Burnham's statement written on Exhibit A's face accurately portrays the origin and purpose of  
26 Exhibit A. The court notes the earlier statement was made contemporaneously with the document's  
27 creation, was inscribed on its face, and was made without the assistance of an attorney. By contrast,  
28 the Burnham declaration was prepared by Spot's attorneys after the initiation of litigation. The court

1 also notes that the Burnham declaration was only created only after Spot became aware that the court  
2 may not grant Exhibit A protection under the attorney-client privilege.<sup>3</sup>

3 Second, the Burnham declaration states that Exhibit A “was in fact given to and discussed with  
4 the attorneys at Seed IP.” (Burnham Decl., Doc. #122 at 1:10-11.) Importantly, however, the  
5 declaration does not state when Exhibit A was allegedly given to Spot’s attorneys, how it was allegedly  
6 communicated to Spot’s attorneys, which attorneys allegedly received Exhibit A, or when its contents  
7 were allegedly discussed. (*See id.*) Without such facts the Burnham declaration is a conclusory  
8 “blanket assertion” of the attorney-client privilege, which the Ninth Circuit extremely disfavors.  
9 *Martin*, 278 F.3d at 1000.

10 In sum, Spot has failed to satisfy its burden of demonstrating that Exhibit A is entitled to  
11 protection under the attorney-client privilege. The document’s four corners do not demonstrate that  
12 it is entitled to protection. Further, Spot’s repeated assertions during oral argument and in its brief that  
13 it has an “e-mail between Seed IP and Spot Devices on May 24, 2005 discussing the contents of  
14 Exhibit A” is flatly contradicted by the actual contents of the May 24, 2005, email. Despite Spot’s  
15 various representations and promises of reliable evidence, Exhibit A is precisely what it at first glance  
16 appears to be: an internal business memorandum written by a Spot employee for a Spot employee,  
17 which Spot inadvertently produced and, now, cannot retrieve.

18 Spot has failed to carry its burden of establishing the applicability of the attorney-client  
19 privilege with regard to Exhibit A.

20 ***B. Exhibit A is not Protected by the Work Product Doctrine***

21 Spot further asserts that Exhibit A is protected by the work product doctrine. The gist of Spot’s  
22 argument is that because Exhibit A was created one month after LightGuard informed Spot that Spot  
23 may be infringing LightGuard’s patents, the court should infer that Exhibit A was created in  
24 anticipation of litigation. (Def.’s Suppl. Br., Doc. #121 at 2-3.) Where dual-purpose documents are  
25 involved, that is documents that serve both business and litigation purposes, courts apply the “because  
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27 <sup>3</sup> On December 30, 2011, Spot submitted its first privilege brief. (Doc. #109.) On January 19, 2012,  
28 the court issued an order requesting Spot to clarify why it believed Exhibit A was privileged. (Doc. #115.)  
On January 30, 2012, Burnham executed the Burnham declaration. (Doc. #122.)

1 of” test when determining whether the work product doctrine applies. *Richey*, 632 F.3d at 567-68  
2 (citing *In Re Grand Jury Subpoena*, 357 F.3d at 907). Under the “because of” test, the party seeking  
3 protection must demonstrate that the document was created because of impending litigation. *Id.* Spot  
4 has not satisfied this test.

5 First, the plain language of Exhibit A’s introduction, which memorializes Exhibit A’s purpose  
6 and the context of its creation, makes no mention of impending litigation. (*See* Joint Stip. Ex. List,  
7 Doc. #105 at Ex. A.) Rather, Exhibit A explicitly states that it was created for the business purpose  
8 “of reducing the number of constraints on Spot Devices’ future designs.” (*Id.*) Importantly, the  
9 introduction memorializing the context of Exhibit A’s creation makes no mention of LightGuard or  
10 impending litigation. (*Id.*) Furthermore, the inclusion of the final two words, “future designs” is  
11 significant because it rebuts Spot’s contention that the memo was written in response to Spot’s current  
12 or past designs, which form the subject matter of this lawsuit.

13 Second, although plausible in theory, Spot’s contention that the temporal proximity between  
14 LightGuard’s notice of potential litigation and Exhibit A’s creation indicates that Exhibit A was  
15 created in anticipation of litigation fails on the facts. (Def.’s Suppl. Br., Doc. #121 at 2-3.) As noted  
16 above, Exhibit A’s introduction clearly states that it was prepared for the business purpose of  
17 “reducing the number of constrains on Spot Devices’ future designs.” (Joint Stip. Ex. List, Doc. #105  
18 at Ex. A.) This fact alone undermines Spot’s attempt to link Exhibit A’s creation with LightGuard’s  
19 notice of potential litigation. As a result, the court cannot conclude that the temporal proximity  
20 between LightGuard’s notice of potential litigation and Exhibit A’s formulation demonstrates that  
21 Exhibit A was created in anticipation of litigation.

22 In sum, whether judged by the general rule or the “because of” test, the work product doctrine  
23 requires the party asserting protection to somehow link the disputed document with the prospect of  
24 impending litigation. Spot failed to do this for two reasons. First, Spot’s Exhibit A states on its face  
25 that it was created for business purposes. Second, Spot’s argument, which relies exclusively on  
26 temporal proximity, ignores what Exhibit A states on its face: that it was created for the business

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1 purpose of “reducing the number of constraints on Spot Devices’ *future designs*.” (Joint Stip. Ex. List,  
2 Doc. #105 at Ex. A; emphasis added.)

3 Exhibit A is not, therefore, entitled to protection under the work product doctrine.

4 ***C. Exhibits B-L are not Protected by the Attorney-Client Privilege***

5 LightGuard and Spot further dispute whether the attorney-client privilege protects a number  
6 of discrete statements found in operating plans, sales and financial reports, and PowerPoint  
7 presentations, which Spot presented to its board of directors. (*See* Doc. #107 at 10-13; Doc. #109 at  
8 8-9.) As with Exhibit A, Spot bears the burden of demonstrating that the statements found in  
9 Exhibits B-L are entitled to protection. *Martin*, 278 F.3d at 999-1000. Spot, however, erroneously  
10 argues the secondary issue of whether LightGuard waived the ability to contest any purported privilege  
11 which might attach to Exhibits B-L. The court cannot conclude that Spot has satisfied its burden of  
12 demonstrating that the attorney-client privilege protects the statements in Exhibits B-L from  
13 disclosure.

14 In both its briefs, and at the February 15, 2012, hearing, Spot predicates its assertion that the  
15 statements in Exhibits B-L are protected by the attorney-client privilege on the existence of an oral  
16 agreement between Spot and LightGuard. (Doc. #109 at 8:18-25; Doc. #121 at 4:16-18.) According  
17 to Spot, Spot allegedly agreed to leave Exhibits B-L unredacted for LightGuard’s use during a  
18 deposition in exchange for LightGuard’s promise that LightGuard would not allege that Spot waived  
19 the privilege by leaving the documents unredacted. (*Id.*) Spot further contends that the terms of the  
20 agreement extended beyond the use of the unredacted document during the deposition and prohibited  
21 any prior or future use of the unredacted document. (Doc. #109 at 8:18-25; Doc. #121 at 4:16-18.)

22 Several problems beset Spot’s position. First, the deposition transcript memorializing the  
23 alleged agreement only specifically identifies one exhibit. (*Id.* (“MR. HEMMINGER: ‘Over the break  
24 we were able to resolve – reach an agreement as to how to go forward at least with respect to  
25 Exhibit 821’”).) Allusions are made to “other documents” but none are identified. (*Id.* at 6:19-25,  
26 7:1-8.) The court is, therefore, invited to speculate which, if any, of the exhibits docketed as  
27 Exhibits B-L is Exhibit 821 and whether the “other documents” alluded to are, in fact, the remaining  
28 documents docketed as Exhibits B-L. Spot, however, offers no explanation for these discrepancies.



1 As a result, the court is reluctant to hold LightGuard to an agreement limiting the legal arguments at  
2 its disposal when the exact documents subject to the agreement were not identified on the record.

3 Second, assuming LightGuard and Spot reached an agreement, its terms are facially ambiguous.  
4 The deposition transcript indicates that the parties discussed the possibility of coming to an agreement  
5 throughout the morning and that they disagreed on the agreement's duration. (*See* Doc. #121-1 at  
6 4:20-23, 5:2-5 ("MR. McMILLEN: 'For purposes of today's deposition, that's fine.'  
7 MR. HEMMINGER: 'No, no, no. It's not for today's, it's forever.'").) When the alleged agreement  
8 was reached, however, the parties were off the record and Spot failed to memorialize the agreement's  
9 terms on the record. (*See Id.* at 6:11-17.) There is, as a result, nothing on the record to corroborate  
10 Spot's position that the alleged agreement was "forever" or any evidence to rebut LightGuard's  
11 assertion that it was not.

12 Third, Spot's perseverance on the alleged agreement, which concerns the issue of waiver, is  
13 inapposite. Under the terms of the alleged agreement, LightGuard merely agreed to allow the  
14 deposition to continue on the condition that any examination of witnesses regarding the documents  
15 would not constitute a waiver, if any, of the attorney-client privilege. Importantly, LightGuard did not  
16 agree that the attorney-client privilege even attached to the documents. As a result, Spot still bears the  
17 burden of demonstrating that the statements, in the first instance, are in fact privileged. *Martin*, 278  
18 F.3d at 999-1000 (stating the burden of proving whether the privilege exists rests on the party asserting  
19 the privilege); *see also Weil*, 647 F.2d at 24 (stating that the privilege is strictly construed). Spot has  
20 failed to satisfy this burden for several reasons.

21 Spot contends that the statements in Exhibits B-L are entitled to protection because they reveal  
22 "the subject matter of the legal advice sought or matters on which legal advice was sought." (Doc.  
23 #119 at 5:3-4.) The attorney-client privilege, however, protects confidential communications, not  
24 "subject matters." *Graf*, 610 F.3d at 1156; *see also Upjohn Co.*, 449 U.S. at 395-96 (quoting  
25 *Philadelphia v. Westinghouse Elec. Corp.*, 205 F.Supp. 830, 831 (D.Pa. 1962) ("[T]he protection of  
26 the privilege extends only to communications and not to facts. A fact is one thing and a  
27 communication concerning that fact is an entirely different thing".) 8 Wigmore, Evidence § 2292  
28 (1961).

1 Further, Spot has failed to proffer any argument that the disputed statements qualify as  
2 communications to counsel seeking legal advice. (*See* Def.'s Supp. Br., Doc. #121; (Def.'s Opp'n  
3 Doc. #109.) Rather, in both its briefs and during the February 15, 2012, hearing, Spot relied on  
4 inapposite case law, which again addressed the issue of waiver. *See PG&E v. United States*, 69 Fed.  
5 Cl. 784, 811 (Ct. Cl. 2006) (noting that a company's disclosure of information to its board of directors  
6 does not waive the attorney-client privilege); *Great Plains Mut. Ins. Co. v. Mut. Reinsurance Bureau*,  
7 150 F.R.D. 193, 198 (D. Kan. 1993) (noting the same); *Jones v. Nat'l Counsel of YMCA of the USA*,  
8 No. 09-C-6437, 2011 WL 170122, at \*2 (N.D. Ill May 3, 2011) (noting the same) (cited in (Doc. #109  
9 at 8:27:28, 91-7).

10 Finally, even if Spot properly formulated its argument, the exhibits would not be entitled to  
11 protection because there is no indication that the disputed statements seek legal advice. When  
12 determining whether a document seeks legal advice, courts have examined the nature, content, and  
13 context in which the document was prepared. *AT&T Corp.*, 2003 WL 21212614 at \*3 (N.D. Cal.  
14 2003) (citation omitted). Here, the nature, content, and context of Exhibits B-L militate against  
15 protection.

16 With regard to the *nature* of the exhibits, all are internal documents that were created to present  
17 to Spot's board of directors. (Doc. #105 at Ex. B-L.) There is, as a result, no evidence suggesting that  
18 Exhibits B-L were created with an intent to seek legal advice and no evidence suggesting that the  
19 exhibits were actually used to obtain legal advice. The *content* of the exhibits similarly militates  
20 against protection. Although a number of the contested statements address LightGuard's patents (*e.g.*,  
21 "design concept development as work around for LG patent;" "Evaluate LG Patent;" "LG patent  
22 situation – implications for Product Development"), none of the statements indicate that the exhibits  
23 were created to obtain legal advice and, significantly, none can be reasonably construed as  
24 communications. (*See id.*) Finally, the *context* of the exhibits' preparation also militates against  
25 protection. By Spot's own admission (*see id.*), Exhibits B-L are a collection of operating plans, sales  
26 and financial reports, and PowerPoint presentations that were presented to Spot's board of directors.  
27 (Doc. #109 at 8:24.) The court cannot, as a result, discern any evidence indicating that the exhibits  
28 were created to seek legal advice.

1 In conclusion, Spot has failed to demonstrate that Exhibits B-L are protected by the attorney-  
2 client privilege. Although its arguments fail for a variety of reasons as addressed above, Spot's failure  
3 can be briefly summarized by two points. First, in both its briefs and at oral argument, Spot  
4 unconvincingly argued that Exhibits B-L are protected by an oral agreement between LightGuard and  
5 Spot. However, even if the court accepted Spot's version of the alleged agreement, which it does not,  
6 the agreement is inapposite because it only addresses the issue of waiver. According to Spot,  
7 LightGuard orally agreed to allow the deposition to continue on the condition that any examination  
8 of witnesses regarding the documents would not constitute a general waiver of the attorney-client  
9 privilege. Significantly, nothing in the alleged agreement demonstrates that the attorney-client  
10 privilege attached.

11 This brings the court to Spot's second major failing, namely, Spot failed to establish that the  
12 disputed statements in Exhibits B-L qualify as communications to counsel seeking legal advice. (*See*  
13 *Def.'s Supp. Br., Doc. #121; Def.'s Opp., Doc. #109.*) Rather, in both its briefs and during the  
14 February 15, 2012, hearing, Spot relied on inapposite case law, which again addressed the issue of  
15 waiver. *See, e.g., PG&E*, 69 Fed. Cl. at 811 (discussing waiver). The key question to begin with is  
16 whether the exhibits are protected by the attorney-client privilege, which they are not.

17 As a result, Spot has failed to satisfy its burden. The court, therefore, concludes that  
18 Exhibits B-L are not protected by the attorney-client privilege.

19 ***D. Certain Documents Identified in Exhibit M not Privileged***

20 LightGuard and Spot's final privilege dispute involves Spot's privilege log, Exhibit M, which  
21 consists of fifty-three emails and attachments docketed as sub-exhibits 1-50, 71-73. (Doc. #131.)  
22 During the February 15, 2012, hearing, LightGuard and Spot presented arguments as to whether  
23 Exhibit M complied with the factors governing privilege logs as articulated by *Dole v. Milonas*, 889  
24 F.2d 885, 888 n.3 (9th Cir. 1989) and *In re Grand Jury Investigation*, 974 F.2d 1086, 1071 (9th Cir.  
25 1989). Because the court was unable to determine whether the documents referenced in the log  
26 complied with Ninth Circuit precedent, the court ordered Spot to produce the documents listed in

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1 Exhibit M for *in camera* review.<sup>4</sup> On February 23, 2012, Spot filed the documents listed in Exhibit M  
2 and the May 24, 2005, email for *in camera* review. (See Doc. #131.)

3 After reviewing Spot's briefs, exhibits, and considering its arguments, the court concludes that  
4 the documents identified in Exhibit M are entitled to protection under the attorney-client privilege with  
5 the exception of the following nine exhibits:

6 **First**, Exhibit 2, which is an email from Chris Peddie to Thomas Burnham dated September 9,  
7 2005, regarding "V2 & LG" (Doc. #131, Ex. 2);

8 **Second**, Exhibit 10, which is an email from Dave Bim-Merle to Thomas Burnham dated  
9 September 26, 2005, regarding "Patent" (Doc. #131, Ex. 10);

10 **Third**, Exhibit 11, which is also an email from Dave Bim-Merle to Thomas Burnham dated  
11 September 26, 2005, regarding "Patent" (Doc. #131, Ex. 11);

12 **Fourth**, Exhibit 20, which is an email and attachment from Chris Peddie to Thomas Burnham  
13 dated October 4, 2005, regarding "Flush Road Maker Patent.doc" (Doc. #131, Ex. 20);

14 **Fifth**, Exhibit 21, which is an email from Chris Peddie to Thomas Burnham dated October 4,  
15 2005, regarding "Varga" (Doc. #131, Ex. 21);

16 **Sixth**, Exhibit 27, which is an email from Chris Peddie to Thomas Burnham dated  
17 November 14, 2005, regarding "FW: Supercapacitor proposal for solar road warning light" (Doc. #131,  
18 Ex. 27);

19 **Seventh**, Exhibit 43, which is an email from Thomas Burnham to Chris Peddie dated July 1,  
20 2010, regarding "Lightguard" (Doc. #131, Ex. 43);

21 **Eighth**, Exhibit 47, which is an email from Chris Peddie to Sandi Dunymer dated July 1, 2010,  
22 regarding "LG Letter" (Doc. #131, Ex. 47); and,

23 **Ninth**, Exhibit 48, which is an email from Chrid Peddie to Sandi Dunymer dated July 2, 2010,  
24 regarding "LG Letter" (Doc. #131, Ex. 48.)

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27 <sup>4</sup> The court's review of Exhibit M and the documents Spot produced for *in camera* review was made  
28 difficult by Spot's failure to provide any information concerning the identity of the emails' authors. Whether  
the authors were LightGuard employees, Spot employees, or attorneys remained open questions Spot left for  
the reader of the log—and the court—to decipher.

1           ***Additionally***, as discussed above, *see supra* pp. 11-12, the court concludes that Exhibit 73,  
 2       which is an email from Frank Abramonte to Timm Peddie, Thomas Burnham, and Peter Dyer dated  
 3       May 24, 2005, regarding “packet”(Doc. #131, Ex. 73), is not entitled to protection under the attorney-  
 4       client privilege.

5           The court reiterates that Spot had the burden of demonstrating that the documents are entitled  
 6       to protection. *See Martin*, 278 F.3d at 999–1000 (holding that the party asserting the attorney-client  
 7       privilege bears the burden of demonstrating each element); *see also Tornay*, 840 F.2d at 1426 (stating  
 8       that the party asserting the work product doctrine bears the burden of demonstrating that it applies).  
 9       The ten aforementioned documents are not entitled to protection because they either do not seek legal  
 10      advice or communicate with counsel. Spot’s brief (Doc. #131) offered the court no guidance as it did  
 11      not argue why the documents are entitled to protection. The court, however, will retain the identified  
 12      documents under seal in order to afford Spot the opportunity to object to the court’s conclusions  
 13      regarding the identified documents. All other documents that Spot produced for the court’s *in camera*  
 14      review, Exhibits 1, 3-9, 12-19, 22-26, 28-42, 44-46, 49-50, and 71-72, are privileged and need not be  
 15      produced to LightGuard.

#### 16       ***E.       The Payment Dispute***

17           The facts underlying LightGuard and Spot’s second discovery dispute, which concerns fees  
 18      owed to a discovery vendor, are recounted above. *See, supra*, Section I.B. LightGuard and Spot’s  
 19      payment dispute sends the parties down a well-worn path. Federal Rule of Civil Procedure 34(a)(1)  
 20      provides that “[a] party may serve on any other party a request” to “produce and permit the requesting  
 21      party or its representative to inspect, copy, test, or sample ... any designated document or electronically  
 22      stored information. Fed. R. Civ. Pro. 34(a)(1). When responding to such a request, “the presumption  
 23      is that the producing party should bear the cost of responding to properly initiated discovery  
 24      requests[.]” *Oppenheimer Fund, Inc.*, 437 U.S. at 358.

25           However, this presumption neither abrogates the general presumption that each party bears the  
 26      “ordinary burden of financing his own suit” nor burdens the responding party with photocopying  
 27      expenses. *Eisen*, 417 U.S. at 94; *see also Tierno*, No. 05-02520, 2008 WL 3876131 at \*1 (N.D. Cal.  
 28      Aug. 19, 2008) (citing 7 *Moore’s Federal Practice* § 34.13[5] at 34-92 (2008) (addressing the

1 requesting party's duty to pay photocopying expenses)). As the plain language of Rule 34(a)(1)  
2 indicates, the responding party is required to produce the documents for copying, not the funds to  
3 finance the documents' photocopying. *See* Fed. R. Civ. Pro. 34(a)(1).

4 LightGuard's allegation that Spot is liable for half of the photocopying expenses is  
5 unsubstantiated by law and fact. First, LightGuard misunderstands the law governing document  
6 production. In support of its contention that Spot is liable for half of the photocopying expenses  
7 arising from Sierra Legal's services, LightGuard cites a number of cases that refer to the Supreme  
8 Court's statement in *Oppenheimer Fund, Inc.* that the "producing party should bear the cost of  
9 responding to properly initiated discovery requests." 437 U.S. at 358; *see* Doc. #123 at 2:4-14 (citing  
10 *Mezu v. Morgan State Univ.*, 269 F.R.D. 565, 575 (D. Md. 2010); *United States v. Columbia Board*  
11 *Sys. Inc.*, 666 F.2d 364, 371 (9th Cir. 1982); *In re Grand Jury No. 76-3 (MIA Subpoena Duces Tecum*,  
12 555 F.2d 1306, 1308 (5th Cir. 1977)).

13 LightGuard's citation to *Oppenheimer Fund, Inc.* is inapposite because *Oppenheimer Fund*,  
14 *Inc.* addresses costs associated with *responding* to discovery requests. *Id.* As described in *In re Puerto*  
15 *Rico Elec. Power Authority*, 687 F.2d 501, 508 (P.R. Cir. 1982), responding to discovery requests  
16 includes answering interrogatories, submitting to depositions, and producing documents for the other  
17 party's inspection, copying, testing, or sampling. *Id.* Expenses associated with photocopying are, in  
18 other words, in a different realm than the expenses associated with responding to requests addressed  
19 by the Supreme Court in *Oppenheimer Fund, Inc.*

20 Even if *Oppenheimer Fund, Inc.* addressed photocopying expenses, which it did not, the  
21 Supreme Court gave no indication that it was abrogating the more general presumption that each party  
22 bears the "ordinary burden of financing his own suit." *Eisen*, 417 U.S. at 94. Rather, the law  
23 governing discovery requests and document production clearly states that the requesting party bears  
24 expenses associated with photocopying. *See Tierno*, No. 05-02520, 2008 WL 3876131 at \*1 (N.D.  
25 Cal. Aug. 19, 2008) (citing 7 *Moore's Federal Practice* § 34.13[5] at 34-92 (2008) ("A party  
26 producing documents will ordinarily not be put to the expense of making copies for the requesting  
27 party")); *see also Bills v. Kennecott Corp.* 108 F.R.D. 459, 462 (D. Utah 1985) ("Ordinarily, the  
28 producing party bears the costs of reviewing and gathering documents while the requesting party pays

1 for the costs of the copies only”); *Clear View Investments, Ltd. v. Oshatz*, 233 F.R.D. 393, 394  
 2 (S.D.N.Y. 2006) (stating the same); *Obiajulu v. City of Rochester, Dept. of Law*, 166 F.R.D. 293, 297  
 3 (W.D.N.Y. 1996) (stating the same).

4 Second, LightGuard’s allegation that Spot is liable for half of the photocopying expenses is  
 5 unsubstantiated by the facts. Although Federal Rule of Civil Procedure 34, *Oppenheimer Fund, Inc.*  
 6 and *Eisen* establish the general rule that the responding party is responsible for costs associated with  
 7 responding to requests while the requesting party is responsible for subsequent costs, including  
 8 photocopying, these are merely default rules, which the parties can contractually alter. *See, e.g.,*  
 9 *Bobrosky v. Vickers* 170 F.R.D. 411, 415 (W.D. Va. 1997) (discussing how parties may alter discovery  
 10 procedures in the context of Rule 29.) LightGuard, however, has provided no evidence indicating that  
 11 the parties actually agreed to alter the default rules. On the contrary, the evidence demonstrates that  
 12 Spot repeatedly rejected LightGuard’s cost sharing proposal. (*See, e.g.,* Doc. #126-2 at 2; Doc. #126-3  
 13 at 2; Doc. #126-4 at 3; Doc. #126-7 at 2 (stating Spot will “not incur the cost of making copies in this  
 14 litigation”).) As a result, the court cannot conclude that LightGuard and Spot reached a meeting of the  
 15 minds concerning cost sharing for photocopying expenses.

16 The law clearly states that the responding party is only responsible for costs associated with  
 17 responding to requests for production whereas the requesting party is responsible for subsequent costs.  
 18 Because LightGuard has not established a meeting of the minds between LightGuard and Spot to  
 19 contractually alter the law’s default discovery rules, the court determines that Spot is only liable for  
 20 the costs associated with converting the documents into LightGuard’s requested format whereas  
 21 LightGuard is responsible for expenses arising from Sierra Legal’s photocopying services. (Doc.  
 22 #127.)

#### 23 IV. CONCLUSION

24 In conclusion, Spot has failed to demonstrate that Exhibit A is entitled to protection under  
 25 either the attorney-client privilege or the work product doctrine. It has also failed to demonstrate that  
 26 Exhibits B-L, as well as the ten aforementioned sub-exhibits identified in Exhibit M, are entitled to  
 27 protection under the attorney-client privilege.

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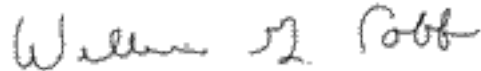
1 LightGuard has failed to demonstrate that Spot agreed to equally apportion expenses associated  
2 with photocopying Spot's production.

3 IT IS THEREFORE ORDERED that, with regard to Exhibits A-L and sub-exhibits 2, 10, 11,  
4 20, 21, 27, 43, 47, 48, and 73 identified in Exhibit M, LightGuard's Emergency Motion to Compel  
5 (Doc. #74) is **GRANTED**.<sup>5</sup>

6 IT IS FURTHER ORDERED that LightGuard's motion to apportion photocopying expenses,  
7 which came before the court during a January 24, 2012, status conference (Doc. #118) is **DENIED**.

8 **IT IS SO ORDERED.**

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10 DATED: March 9, 2012.

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12 WILLIAM G. COBB  
13 UNITED STATES MAGISTRATE JUDGE  
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28 <sup>5</sup> These documents shall remain under seal to afford Spot the opportunity to object.